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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,431	03/06/2002	Siba K. Samal	108172-00070	2502

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EXAMINER

SCHEINER, LAURIE A

ART UNIT	PAPER NUMBER
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1648

DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/926,431

Applicant(s)

SAMAL ET AL.

Examiner

Laurie A. Scheiner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 8-18 and 20-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 19, 26 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/13/03 6 10 31 01
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Priority***

Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional applications upon which priority is claimed fails to fully provide adequate support under 35 U.S.C. 112 for claims 1-7, 19, 26 and 27 of this application.

### ***Information Disclosure Statement***

The information disclosure statement filed January 13, 2003 has been considered. An initialed copy is enclosed.

### ***Election/Restrictions***

Applicant's election of Group I (claims 1-7, 19, 26 and 27) on October 15, 2003 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7, 19, 26 and 27 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

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application was filed, had possession of the claimed invention. *In re Rasmussen*, 650 F.2d 1212, 211 U.S.P.Q. 323 (C.C.P.A. 1981). *In re Wertheim*, 541 F.2d 257, 191 U.S.P.Q. 90 (C.C.P.A. 1976). Claims 1-7, 19, 26 and 27 are drawn toward a Newcastle disease virus (Z) vaccine. The written description requirement under Section 112, first paragraph, sets forth that the claimed subject matter must be supported by an adequate written description that is sufficient to enable anyone skilled in the art to make and use the invention. The courts have concluded that the specification must demonstrate that the inventor(s) had possession of the claimed invention as of the filing date relied upon. Although the claimed subject matter need not be described identically, the disclosure relied upon must convey to those skilled in the art that applicants had invented the subject matter claimed. *In re Wilder, et al.*, 222 U.S.P.Q. 369 (C.A.F.C. 1984). *In re Wertheim, et al.*, 191 U.S.P.Q. 90 (C.C.P.A. 1976). *In re Driscoll*, 195 U.S.P.Q. 434 (C.C.P.A. 1977). *Utter v. Hiraga*, 6 U.S.P.Q.2d 1709 (C.A.F.C. 1988). *University of California v. Eli Lilly*, 119 F.3d 1559, 43 U.S.P.Q.2d 1398 (Fed. Cir. 1997). *Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*, 18 U.S.P.Q.2d 1016-1031 (C.A.F.C. 1991). *Fiers v. Sugano*, 25 U.S.P.Q.2d 1601-1607 (C.A.F.C. 1993). *In re Bell*, 26 U.S.P.Q.2d 1529-1532 (C.A.F.C. 1993). The significance of conception and reduction to practice was further addressed by the court in *Fiers v. Sugano* where it was emphasized that “[c]onception is a question of law, reviewed *de novo* on appeal, and if inventor is unable to envision detailed chemical structure of DNA sequence coding for specific protein, as well as method of obtaining it, then conception is not achieved until reduction to practice has occurred, that is, until after gene has been isolated; thus, regardless of complexity or simplicity of method of isolation employed, conception of DNA sequence, like conception of any chemical substance, requires definition of that substance other than by its functional utility.” Thus, the courts have emphasized that the inventor must clearly and unambiguously identify the salient characteristics and properties of any given claimed

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nucleotide sequence. It is not sufficient to provide a vague reference to the biological activity of any given nucleotide sequence or merely a generic method of obtaining it.

Applicants' disclosure fails to provide adequate written support for the invention as claimed. That is, applicants' claims encompass a viral vaccine wherein the virus has at least two of three recited following features: (1) an F<sub>0</sub> protein cleavage site having at least 2 less basic amino acid residues than an F<sub>0</sub> protein cleavage site of the Beaudette C strain of NDV; (2) an amino acid having a non-aromatic side chain at the N terminus of the F<sub>1</sub> cleavage fragment, wherein the amino acid having a non-aromatic side chain is glycine, alanine, valine, leucine or isoleucine; and (3) an open reading frame of a HN glycoprotein being longer than an open reading frame of a HN glycoprotein of Newcastle disease virus wild type strain Beaudette C. However, the disclosure fails to provide an adequate written description for subject matter as claimed. The examiner contends that one of skill cannot reproduce that which has not been described. That is, it is evident that applicants were not in possession of that which is claimed at the time of the invention. It is well settled that the claimed subject matter need not be supported by an explicit, word for word recitation, but something more than a suggestion is needed to satisfy the requirement for an adequate written description. As set forth in Lockwood v. American Airlines Inc., 107 F.3d 1565, 1571-1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997): It is the disclosures of the applications that count. Entitlement to a filing date extends only to that which is disclosed. While the meaning of terms, phrases, or diagrams in a disclosure is to be explained or interpreted from the vantage point of one skilled in the art, all the limitations must appear in the specification. Rather, a[n]... application itself must describe an invention, and do so in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention as of the filing date sought... [A]ll that is necessary to satisfy the description requirement is to show that one is "in possession" of the invention... One shows that one is "in possession" of the invention by describing the invention, with all its claimed limitations, not that which makes it obvious. . . Although the exact terms need not be used in haec verba, . .

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. the specification must contain an equivalent description of the claimed subject matter.

[Citations omitted]

It is not sufficient for purposes of the written description requirement of Section 112 that the disclosure, when combined with knowledge in the art, would lead one to speculate as to modifications that the inventor might have envisioned, but failed to disclose. Each application must describe the claimed features. Thus, it is not enough for applicant to state that one of skill would know how to make or find a modified Beuadette C strain. Is NDV Z known and available to the public? Does the NDV Z genome have a longer HN glycoprotein open reading frame relative to the wild type strain? At what positions are the at least two basic amino acid residues removed and/or replaced? How much longer with respect to wild type is the open reading frame of the NDV HN glycoprotein? At best, it appears that applicants describe only an NDV codon (AGA) replaced by codon (TCC) at position -2 of the F<sub>0</sub> cleavage site; NDV codon (AGG) replaced by codon (TCC) at position -5 of the F<sub>0</sub> cleavage site; and codon (CTC) at position +1 of the N terminus of F<sub>1</sub>. The specification fails in demonstrating that the described vaccine will not revert to a virulent phenotype; similarly, it is not evident that applicants were in possession of an apathogenic phenotype at the time of filing. The specification fails to provide an adequate written description for the vaccine of claim 1 wherein at least one gene encodes an avian cytokine (or interleukin).

### ***Conclusion***

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Scheiner, whose telephone number is (571) 272-0910. Due to a flexible work schedule, the examiner's hours typically vary each day. However, the examiner can normally be reached Monday thru Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached on (571) 272-

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0902. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (571) 272-1600.

Correspondence related to this application may be submitted to Group 1600 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Laurie Scheiner/LAS  
March 9, 2005



Laurie Scheiner  
Primary Examiner  
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